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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/666,868

09/18/2003

Les Keay

AUS920030590US1

8474

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7590

10/29/2007

IBM CORP. (WIP)

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EXAMINER

PARK, GEORGE M

ART UNIT

PAPER NUMBER

4114

MAIL DATE

DELIVERY MODE

10/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/666,868	Applicant(s) KEAY ET AL.	
	Examiner George Park	Art Unit 4114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/18/2003 and 11/13/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The term “PO & invoice profile, block 208” (page 9, lines 25-26) should be --PO & invoice profile, block 206--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 4, 12, 13 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, 4, 12, 13 and 19 recites the limitation "the group" in page 23, lines 21 and 29, page 25, lines 22 and 29, page 27, line 9, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5, 7-12, 14, 16-18 and 20 are rejected under 35 U.S.C. 102(e) as being unpatentable by Engelking et al. (U.S. Pub. No. 2005/0049911 A1).

Regarding to claims 1, 10 and 16, Engelking et al. discloses a method, system, and computer-usable medium (i.e. computer-readable media), having computer-executable instructions (paragraph [0007], lines 1-10, paragraph [0009], lines 1-5, paragraph [0028], lines 1-16, see claim 15) said method, system and computer-usable medium, having computer-executable instructions for simulation (i.e. modeling) (paragraph [0006], lines 1-3) comprising: means for receiving for at least one business transformation outsourcing service (paragraph [0007], lines 21-25), spending inputs (i.e. operating costs) (paragraph [0055], lines 5-9, paragraph [0056], lines 1-5, paragraph [0060], lines 1-2), process inputs (i.e. implementation/process costs) (paragraph [0062], lines 1-5, paragraph [0063], lines 1-9, paragraph [0088], lines 1-3 and 8-13), and information technology inputs (i.e. technology costs) (paragraph [0033], lines 1-3 and 13-21, paragraph [0060], lines 12-16, paragraph [0071], lines 1-4, paragraph [0075], lines 1-4); based and means responsive to said inputs, for performing a spending simulation (i.e. costs) (paragraph [0092], lines 1-4, paragraph [0093], lines 1-6), a process simulation (i.e. implementation) (paragraph [0062], lines 1-11, paragraph [0092], lines 1-4, paragraph [0127], lines 1-7), and an information technology simulation (i.e. technology/equipment upgrades) (paragraph [0041], lines 1-9, paragraph [0092], lines 1-4); means for computing net savings values (i.e. total savings/cost savings) (paragraph [0041], lines 9-13, paragraph [0049], lines 1-6, paragraph [0097], lines 5-6), based on said simulations; means for performing a value simulation (i.e. economic impact) (paragraph [0050], lines 1-10,

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paragraph [0093], lines 1-6, paragraph [0100], lines 1-6), based on said net savings values (i.e. estimated savings); and means for outputting at least one measure of economic value for said business transformation outsourcing service (paragraph [0050], lines 1-10, paragraph [0093], lines 1-6, paragraph [0100], lines 1-6).

Regarding to claims 2, 11 and 17, Engelking et al. discloses mean for outputting cost quantities (i.e. current and future costs) and benefit quantities (i.e. benefit summary/cash benefit) for a plurality of years (paragraph [0201], lines 1-7).

Regarding to claims 3, 12 and 18, Engelking et al. discloses performing one or more simulations (i.e. modeling) selected from the group consisting of a simulation in research and development mode (i.e. Transformation team/ Saratoga) (paragraph [0037], lines 1-7, paragraph [0040], lines 1-13), a simulation in internal use mode (i.e. external for client point of view) (paragraph [0032], lines 24-30), and a simulation in external use mode (i.e. internal for client point of view) (paragraph [0007], lines 21-27, paragraph [0032], lines 8-12, paragraph [0040], lines 1-13, paragraph [0044], lines 10-13, paragraph [0052], lines 7-12).

Regarding to claim 5, 14 and 20, Engelking et al. discloses means for performing a spending simulation (i.e. costs) based on sub-commodity profiles (i.e. sub functions) (paragraph [0033], lines 13-21, paragraph [0041], lines 1-13).

Regarding to claim 7, Engelking et al. discloses a method of simulation (i.e. modeling) (paragraph [0006], lines 1-3), said method comprising performing a spending simulation (i.e. cost) (paragraph [0092], lines 1-4, paragraph [0093], lines 1-6); performing a process simulation (i.e. implementation) (paragraph [0062], lines 1-11, paragraph [0092], lines 1-4, paragraph [0127], lines 1-7); performing an information technology simulation (i.e. technology/equipment

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upgrades) (paragraph [0041], lines 1-9, paragraph [0092], lines 1-4); performing a value simulation (i.e. economic impact) (paragraph [0050], lines 1-10, paragraph [0093], lines 1-6, paragraph [0100], lines 1-6); providing interactions (i.e. comparing to determine most beneficial for client) among said simulations (paragraph [0008], lines 7-11, paragraph [0034], lines 5-8, paragraph [0046], lines 4-7); and representing with said simulations the use by a client organization of one or more business transformation outsourcing services from payables (i.e. accounting) (paragraph [0035], lines 7-14).

Regarding to claim 8, Engelking et al. discloses receiving for said one or more business transformation outsourcing services, spending inputs (i.e. operating costs) (paragraph [0055], lines 5-9, paragraph [0056], lines 1-5, paragraph [0060], lines 1-2), process inputs (i.e. implementation/process costs) (paragraph [0062], lines 1-5, paragraph [0063], lines 1-9, paragraph [0088], lines 1-3 and 8-13), information technology inputs (i.e. technology costs) (paragraph [0033], lines 1-3 and 13-21, paragraph [0060], lines 12-16, paragraph [0071], lines 1-4, paragraph [0075], lines 1-4), and value inputs (i.e. stock price) (paragraph [0056], lines 5-9).

Regarding to claim 9, Engelking et al. discloses outputting cost (i.e. current and future costs) quantities and benefit quantities (i.e. benefit summary/cash benefit) for a plurality of years (paragraph [0201], lines 1-7).

Claim Rejections - 35 USC § 103

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference

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claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-4, 7-13 and 16-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 8-14 and 18-21 of copending Application No. 10/660012. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/660012 deals with benefits inputs while the current patent application deals with spending inputs. The Examiner takes the position that benefits inputs are a form of spending inputs (i.e. spending less money) since when an organization or business procures a benefit it is essentially spending money on a benefit.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 4, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelking et al. (U.S. Pub. No. 2005/0049911 A1).

Regarding to claims 4, 13 and 19, Engelking et al. discloses the invention substantially as claimed. Engelking et al. teaches one or more business transformation outsourcing services selected from the group consisting of accounting (paragraph [0035], lines 7-14). However, Engelking et al. does not explicitly disclose one or more business transformation outsourcing services selected from the group consisting of payables. It is well known in the art and inherent that an accounting system includes a column for accounts payable. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the method, system, and computer-usable medium, having computer-executable instructions of Engelking et al. with the feature of one or more business transformation outsourcing services selected from the group consisting of payables (i.e. accounting) as taught by Engelking et al. The motivation for doing so would be to provide business transformation outsourcing services to an organization or business based on specific needs.

1. Claims 6, 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelking et al. (U.S. Pub. No. 2005/0049911 A1) as applied to claims 1, 10 and 16 above, and further in view of Hoskin et al. (U.S. Pub. No. 2004/0162763 A1).

Regarding to claims 6, 15 and 21, Engelking et al. discloses the invention substantially as claimed. However, Engelking et al. does not disclose making said net savings values at least partly dependent upon compliance with standard processes. Hoskin et al. teaches the sourcing and procurement framework that is compliant with rules and regulations (paragraph [0002], lines 3-5, paragraph [0027], lines 1-7). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the method, system, and

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computer-usable medium, having computer-executable instructions of Engelking et al. with the feature of making said net savings values at least partly dependent upon compliance with standard processes as taught by Hoskin et al., as both Engelking et al. and Hoskin et al. are directed to the method, system, and computer-usable medium, having computer-executable instructions, for business transformation outsourcing service. The motivation for doing so would be to adhere to policy constraints.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stok et al. (U.S. Pub. No. 2003/0033182 A1) teaches a system and method of business planning and/or business process redesign. Jin et al. (U.S. Pat. No. 7,076,474 B2) teaches a system for simulating business processes. Kruk et al. (U.S. Pub. No. 2003/0120528 A1) teaches a method of managing compliance with strategic business rules.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Park whose telephone number is (571) 270-3547. The examiner can normally be reached on Monday - Friday (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Cheng can be reached on (571) 272-4433. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information

/Joe H Cheng/
Supervisory Patent Examiner, Art Unit 4114

GP
10/24/07